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PATENT
Customer No. 22,852
Attorney Docket No. 3804.0128
RPR Docket No. A2080US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of)
U.S. Pat. No. 5,856,121 to)
Gorski et al.)

Serial No.: 09/755,320)

Filed: January 5, 2001)

For: Growth Arrest Homeobox Gene)

Prior Application:

Group Art Unit: 1812

Examiner: C. Saoud

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

SUBMISSION OF INFORMATION UNDER 37 C.F.R. § 1.56

To comply with its duty of candor and good faith under 37 C.F.R. § 1.56, and in the spirit of cooperating with the U.S. Patent and Trademark Office (hereafter, "the Office" or "PTO"), applicants and their assignee, Case Western Reserve University (CWRU), hereby voluntarily disclose to the Office information concerning the conduct of certain present and former employees of their licensee, Rhône-Poulenc Rorer S.A. ("RPR")¹ in prosecuting this patent application before the United States Patent and Trademark Office.

¹ The employees actually worked for the licensee's U.S. affiliate, Rhône-Poulenc Rorer, Inc. In this submission, RPR refers to either RPR S.A. or RPR, Inc. RPR is presently doing business as Aventis Pharmaceuticals Products, Inc.

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Under the terms of the license agreement between CWRU and RPR, RPR had the right to give advice to Calfee, Halter & Griswold, L.L.P. ("Calfee"), patent attorneys for CWRU, in the prosecution of this application, and did so.

The conduct at issue concerns a practice in RPR's U.S Patent Department, now since terminated, of allowing a former PTO patent examiner, who was at the time registered to practice before the Office, to assist in prosecuting matters that may have been within the scope of his 37 C.F.R. § 10.10(b) undertaking.

In light of the possibility that this conduct could be deemed to violate a PTO regulation, RPR hired Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. ("FHFGD"), to conduct a factual investigation. A report detailing the results of that investigation (entitled "Factual Report of an Independent Investigation Conducted on Behalf of Rhône-Poulenc Rorer, Inc.", hereafter, "Report"), and its supporting exhibits,² has been submitted to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.³ A copy of the Report and its supporting exhibits were also filed with the Office of Enrollment and Discipline on October 4, 1999.

² The materials relied upon in this submission, or the relevant portions thereof, are present in the Report and supporting exhibits, which are designated throughout this paper as "Report, page ____" and "Exh. __, page __, P__," where P1, for example, refers to paragraph 1.

³ This Report has been filed in a U.S. Reissue Application (Ser. No. 09/538,305).

INTRODUCTION

The relevant conduct relates to an RPR employee, R. Keith Baker, Ph.D. ("Baker"), as well as certain colleagues with whom Baker worked in RPR's Patent Department, who were involved in the prosecution of this patent application. Prior to working for RPR, Baker was employed as a patent examiner in the PTO for five years, until he resigned on October 28, 1994. Three days after his resignation from the PTO, Baker began his employment at RPR in Collegeville, Pennsylvania.

Under PTO regulations, a former patent examiner (who is registered to practice before the PTO) may not practice before the Office unless he or she signs a written undertaking not to prepare, prosecute or "assist in any manner in the preparation or prosecution" of any patent application disclosing subject matter in his area of responsibility at the PTO. 37 C.F.R. § 10.10(b). Patent examiners sign such an undertaking when they resign from the PTO. This bar applies to patent applications filed prior to and within two years from the date the examiner resigns from the Office.

Since he signed such an undertaking,⁴ Baker was barred from assisting in the prosecution of certain applications pending at the PTO prior to October 28, 1996, and is still barred from assisting in the prosecution of any applications that are the progeny of applications falling within his bar during those two years. Nonetheless, Baker assisted in the prosecution of patent applications that may have fallen within the scope of his

⁴ See Supplemental Exhibit 28.

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undertaking, even though he did not sign papers submitted to, or actually appear before, the Office with respect to such matters. See Report, Part II, Section H. With respect to the instant application, Baker communicated with independent counsel who prepared and prosecuted the instant application for their client, the Edison Biotechnology Center, a non-profit organization for promoting biotechnology in the State of Ohio, and Case Western Reserve University, the assignee. See attached Declaration of Pamela A. Docherty.

Based on information gathered during FHFGD's investigation, applicants believe that Baker's conduct in connection with this application is not material under 37 C.F.R. § 1.56. Even so, applicants, their assignee, and their licensee, are disclosing all information to the PTO that they are aware of pertaining to any possible violation of PTO regulations by its employees. Applicants are filing this submission: (1) expressly advising the PTO of the former examiner's activities, stating specifically where his involvement resides in this application; (2) advising the PTO what the actual facts are, while making it clear that further examination may be required if any PTO action was based on those activities; and (3) establishing patentability of the claimed subject matter based on the new, factually accurate, record. *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 1572 (Fed. Cir. 1983).

Thus, applicants are voluntarily disclosing to the PTO that an RPR patent agent may have violated his PTO undertaking when he assisted "in any manner" in the prosecution of this patent application, as well as all other relevant facts. This disclosure

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is in furtherance of complying with the duty of candor and good faith required by 37 C.F.R. § 1.56 and with any and all disclosure requirements imposed by 37 C.F.R. Part 10.

SPECIFIC CONDUCT AT ISSUE IN THIS APPLICATION

The instant case was Ser. No. 08/203,532, filed on Feb. 24, 1994, now U.S. Pat. No. 5,856,121 (A2080). In an interview with FHFGD attorneys on May 10, 1999, Baker identified this case as one that may have fallen within the scope of his undertaking under 37 C.F.R. § 10.10(b). This patent application, however, was filed and prosecuted by the law firm of Calfee, Halter & Griswold, L.L.P. ("Calfee"), on behalf of CWRU, rather than by attorneys in RPR's patent department. Thus, Calfee, not Baker or any other attorney in RPR's patent department, prepared and signed papers submitted to the PTO in these cases. See Exh. 14, pages 36-40. To the applicants' knowledge, no one at Calfee or CWRU had any reason to be aware of Baker's bar.

Although this patent was prosecuted by Calfee, Baker may have had some minor involvement in its prosecution. According to an internal "Patent/TM Opening Paper" in RPR's internal prosecution file, this case was docketed to Martin F. Savitzky, Esq. ("Savitzky") and to "RG2" (a docketing ID code for Baker). See Exh. 14, page 36. Baker stated he was involved in reviewing drafts of Amendments, Responses, and a Rule 131 Declaration, prepared by Calfee and transmitted to Savitzky for review prior to submission to the PTO by Calfee. See Exh. 14, pages 36-38. In addition, Baker stated

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that he drafted a letter dated September 19, 1995, from Savitzky to Calfee providing comments regarding a draft Response and Rule 131 Declaration. See Exh. 14, page 37.

Furthermore, Baker himself was the addressee of correspondence from Calfee with which they transmitted a file copy of the specification, an amendment as filed, and a status letter. See Exh. 14, pages 37 and 39. According to Baker, he was also present during a few telephone conferences between Calfee and Savitzky, and probably prepared Savitzky (who did most of the talking) for the conferences. See Exh. 14, page 38.

Baker also transmitted copies of allowed claims and discussed specific sequences and strategies for drafting claims with colleagues at RPR S.A. in France. See Exh. 14, pages 39-40.

REMARKS

Although Baker, as a former examiner, may have violated his undertaking under § 10.10(b) when he assisted "in any manner" in the prosecution of this case, applicants submit that Baker's conduct, as well as the conduct of any other practitioner involved in the prosecution of this case, does not rise to the level of inequitable conduct before the Office under the standards set forth in Rule 56 and the relevant case law. In an abundance of caution, however, applicants submit that the effect of any misconduct is

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purged by their disclosure of it to the Office via this submission, as well as the Report and exhibits incorporated by reference.

I. The Conduct at Issue Is Not Material

"Applicants for patents are required to prosecute patent applications in the PTO with candor, good faith, and honesty." *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995). Moreover, applicants are required to disclose material information to the PTO. "[A]ffirmative misrepresentation of a material fact, failure to disclose material information, or submission of false material information, coupled with the intent to deceive" constitutes inequitable conduct. *Id.*

An inequitable conduct analysis requires consideration of several issues before a final determination is reached:

1. The tribunal must determine whether the misrepresentation meets a threshold level of materiality;
2. It must also determine whether the evidence shows a threshold level of an intent to mislead the PTO;
3. Once the threshold levels of materiality and intent have been established, the tribunal weighs materiality and intent because the more material the misrepresentation, the less evidence of intent that will be required in order to find that inequitable conduct has occurred; and

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4. In light of all of the circumstances, the tribunal must then determine whether the applicant's conduct is so culpable that the patent should be held unenforceable.

See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1327 (Fed. Cir. 1998).

The conduct described in this submission does not rise to the level of inequitable conduct because it is not material. First, Baker did not assist "in any manner" in the filing of the parent application upon which this application is based. Second, the relevant conduct does not meet the required threshold level of materiality because the information would not be important to a reasonable examiner in deciding whether to grant a patent, and the applicants did not gain any unfair advantage in the examining process from Baker's involvement. The applicants did not benefit from any undue influence on the examiner(s) responsible for this application stemming from any prior relationship with Baker. The investigation unequivocally shows that during the prosecution of this application Baker did not directly interact with the PTO or its employees. As noted above, he never signed a paper submitted to the Office. Also, during prosecution of this application, he never communicated directly with PTO personnel, either by telephone or in person. See Report, page 49.

Therefore, even assuming that Baker had an intent to deceive the PTO by shielding his involvement in the prosecution of this application from the Office, his actions were not material.

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A. The Former Examiner's Conduct Lacks Materiality

In 1992, the PTO revised Rule 56 to more clearly define the information that applicants are required to disclose to the PTO:

- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and,
 - (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
 - (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

37 C.F.R. § 1.56 (1992) (emphasis added).

This is the administrative standard for materiality in effect during the period of time in which the conduct at issue took place. If information is not material to patentability under this standard, the PTO does not require an applicant to disclose it to the Office.⁵ 57 Fed. Reg. 2023 (1992). The conduct described in the Report and herein does not fall within this definition of information "material to patentability" that an applicant must disclose to satisfy the duty of candor.

⁵ See 37 C.F.R. § 1.56(a) ("There is no duty to submit information which is not material to patentability of any existing claim.").

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While the information that a former examiner may have assisted in prosecuting this application is not cumulative of information already of record, applicants prior failure to disclose Baker's conduct/activities to the PTO does not violate the duty to disclose information material to patentability. Baker's assistance, either alone or in combination with other information, does not establish a *prima facie* case of unpatentability of any claim that was pending in this application. In addition, it does not refute, nor is it inconsistent with, any position taken by applicants in opposing an argument of unpatentability or asserting an argument for patentability. The mere fact that a former examiner may have been involved with this application does not, *per se*, fall within the definition of materiality provided by 37 C.F.R. § 1.56.

Under the definition of materiality set forth in the former Rule 56 as promulgated from 1977 to 1992, "[i]nformation is 'material' when there is a substantial likelihood that a reasonable examiner would have considered the information important in deciding whether to allow the application to issue as a patent." Even under this definition of "materiality," however, Baker's actions relating to the prosecution of this patent are not material.

Baker's involvement was simply not germane to patentability issues considered during examination. His involvement in this application did not change the merits of the arguments and amendments submitted in support of patentability. No confidential information was used in preparing the papers submitted to the PTO. See Report, page 49, n. 44. The examiner(s) who received these papers responded to them based on the

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amendments and/or merits of the arguments therein. Baker's involvement would not have been important to a reasonable examiner in deciding to grant a patent. Consequently, Baker's conduct was not material under the standard of the former Rule 56.

Applicants recognize that while the revised Rule 56 states that submitting all information within the definition of § 1.56(b) will satisfy the duty to disclose information material to patentability, this does not necessarily mean that the broader duty of candor and good faith under § 1.56(a) has been satisfied. 57 Fed. Reg. 2022 (1992); M.P.E.P. § 2001.04 ("The language of 37 CFR 1.56 (and 37 CFR 1.555) has been modified effective March 16, 1992 to emphasize that there is a duty of candor and good faith which is broader than the duty to disclose material information."). In its final rule making in 1992, the PTO stated that amended Rule 56 "does not attempt to define the spectrum of conduct that would lack the candor and good faith in dealing with the Office which is expected of individuals who are associated with the filing or prosecution of a patent application." 57 Fed. Reg. at 2023.

Even if Baker's actions violate his section 10.10(b) undertaking and the broad duty of candor and good faith imposed by Rule 56, his actions do not constitute inequitable conduct. To constitute inequitable conduct, there must be an affirmative misrepresentation or failure to disclose information that gives the applicant an unfair advantage in the examining process. If the conduct in question does not relate to patentability of the claims or does not provide an applicant with an unfair advantage in

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the examining process, it is not material, and thus not a basis for sustaining a finding of inequitable conduct.

For example, one unfair advantage in the examining process that an applicant might seek to obtain is the expedited prosecution of a patent application without conducting a thorough search of the prior art. As one basis for being placed at the head of the examining line, an applicant must make a sworn statement that a prior art search has been done. In *General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 1411 (Fed. Cir. 1994) the Court noted:

The whole point of the PTO requirement that a petition to make special include a sworn statement that the applicant has made a *careful and thorough search* is that, in return for an applicant being put at the head of the examination line, he must make an extra effort to *look for* and produce all relevant prior art, in other words, to assist an examiner who is being asked to expedite examination.

Id.

The Federal Circuit went on to hold that, as a matter of law, making "a false statement in a petition to make special is material if . . . it succeeds in prompting expedited consideration of the application." *Id.* Thus, a misrepresentation relevant to providing required assistance to the examination process, coupled with an intent to deceive, which procured an unfair advantage that the applicant was not entitled to, was found to be material, and an inequitable conduct defense was sustained.

The importance of a misrepresentation's capacity to bear on patentability or the examination process and to induce an examiner to act, thereby providing an unfair

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advantage to the applicant, is also evident in *Regents of the University of California v. Eli Lilly and Co.*, 119 F.3d 1559 (Fed. Cir.), *cert. denied*, 111 S. Ct., 1548 (1997) (hereafter, "*Eli Lilly*"). In *Eli Lilly*, the trial court ruled that one of the patents in suit was unenforceable for inequitable conduct because the applicants used an uncertified plasmid to hasten their determination of rat insulin-encoding cDNA sequences, and misrepresented in their specification that they had used another, certified plasmid.⁶ 119 F.3d at 1569.

On appeal, Eli Lilly argued that the determination of inequitable conduct should be upheld, relying on the holding in *General Electro Music*. *Id.* at 1570. Specifically, Eli Lilly argued that as long as the misrepresentation was made to obtain a patent more quickly than otherwise, then it is sufficient to support a finding of inequitable conduct.⁷ *Id.* The Federal Circuit did not agree that *General Electro Music* supported Eli Lilly's argument.

⁶ In 1976, NIH issued safety guidelines that governed the conduct of all NIH-supported research in the area of recombinant DNA. These guidelines established controlled conditions for the conduct of experiments involving the production of recombinant DNA molecules and their insertion into organisms, *e.g.*, by plasmids. The safety guidelines mandated that no plasmid could be considered to fall within an approved classification until it had been certified for use by the NIH Recombinant DNA Advisory Committee. *Regents of the University of California v. Eli Lilly and Co.*, 39 U.S.P.Q.2d 1225, 1248-49 (D.C. S.D. Ind. 1995).

⁷ The U.C. applicants in the *Eli Lilly* case could not have disclosed using the uncertified vector in their application, because this would have violated NIH guidelines governing recombinant DNA experiments. To file their application earlier, Eli Lilly argued, the inventors falsified the identity of the vector in their application. *Id.* at 1570.

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The court distinguished its holding in that case, based on the impact the asserted misrepresentation had on the examiner:

In *General Electro Music*, we concluded that "a false statement in a petition to make special is material if, as here, it succeeds in prompting expedited consideration of the patent." We so concluded because, by filing a petition to make special, the applicant "requested special treatment and induced reliance on its statement that a prior art search had been conducted." As explained above, UC's alleged mischaracterization of the pMB9 work as an actual example did not induce the examiner to act, or not to act, in reliance thereon. **UC got no advantage in the patent examining process.** Therefore, we conclude that the district court clearly erred in finding that the misidentification of the plasmid was material to patentability.

Id. at 1571; emphasis added.

As was the case in *Eli Lilly*, applicants here received no unfair advantage in the patent examining process. Importantly, there was no opportunity for Baker to exert an undue influence on PTO personnel because he was not directly involved in the prosecution and he was never identified to the PTO with respect to this application.⁸ In

⁸ Because Baker was never identified and did not appear before the Office during prosecution of this case, the present situation is clearly distinguishable from the facts of *Keamey & Trecker v. Giddings & Lewis*, 452 F.2d 579 (7th Cir. 1971), *cert denied*, 173 USPQ 385 (1972) (claims held unenforceable in a patent infringement suit because plaintiff's remedial action did not "cleanse its hands" when an examiner retired from PTO and then worked on reissue of two patents, one of which he had originally allowed). Specifically, in *Keamey Trecker*, the former PTO examiner: (1) was involved with the prosecution of the patent while at the Office; (2) left the PTO to work for the plaintiff who owned that patent; (3) participated in the prosecution of a reissue application of the patent, as well as the reissue of an acquired prior art patent; and (4) spoke directly to the examiner, a previous subordinate at the PTO, during the reissue proceedings. Furthermore, plaintiff's remedial action to purge the prohibited conduct occurred only after the conduct was uncovered during pretrial discovery in an infringement suit brought by the plaintiff.

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addition, the documents and recollections of all present and former staff in the RPR Patent Department interviewed by FHFGD support the conclusion that no confidential information obtained from the PTO was used in prosecuting this or any of the other applications at issue. The lack of any evidence of an unfair advantage to RPR obtained from Baker's involvement in this application further supports the conclusion that his conduct does not satisfy the threshold level of materiality.

A finding of inequitable conduct requires that threshold levels of both intent and materiality be established. *Cf. Allen Organ Co. v. Kimball International, Inc.*, 839 F.2d 1556, 1567-68 (Fed. Cir. 1988) ("[M]ateriality does not presume intent, which is a separate and essential component of inequitable conduct.") Thus, even if Baker had an intent to shield his participation in this application from the PTO, a *prima facie* case of inequitable conduct cannot be established because his conduct was not material under any definition in the relevant PTO regulations and case law.

B. The Conduct of the Other Practitioners Lacks Intent and Materiality

Baker's conduct is not the only conduct that applicants bring to the Office's attention. The conduct of other registered professionals also may be relevant.

As discussed above, Baker communicated with Calfee practitioners, Pamela A. Docherty ("Docherty") and Mary E. Golrick ("Golrick"), with regard to matters in the instant application.

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Baker also appears to have discussed papers with Savitzky that were submitted to the PTO by Calfee. In addition, Baker may have prepared Savitzky for telephone meetings with Calfee regarding this case. Facts uncovered during an independent investigation by FHFGD, however, indicate that Savitzky did not have a clear understanding of Baker's section 10.10(b) undertaking. See Report, page 43.

"To be guilty of inequitable conduct, an applicant must have intended to deceive the PTO by failing to disclose material information." *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 822 (Fed. Cir. 1992). "There must be not only a misrepresentation, but also actual knowledge of falsity" *Jaskiewicz v. Mossinghoff*, 822 F.2d 1053, 1058 (Fed. Cir. 1987). "[T]he involved conduct, viewed in light of all of the evidence, including evidence indicative of good faith, must indicate sufficient culpability to require a finding of intent to deceive." *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 (Fed. Cir. 1988); *Jaskiewicz*, 822 F.2d at 1059 (holding that when determining whether a practitioner has violated his duty of candor under Rule 56, "[t]he PTO must look to all the facts and circumstances involving the questionable conduct before finding intentional misconduct").

Applicants submit that Savitzky and the practitioners at Calfee who prosecuted these applications, namely Docherty and Golrick, did not act with an intent to mislead the PTO. Applicants submit that because they did not know Baker, as a former examiner, was prohibited from assisting in the prosecution of this case, neither Docherty nor Golrick could have had the requisite intent to deceive the PTO.

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Savitzky never had a firm understanding of Baker's PTO bar, in terms of either the barred subject matter or the contours of the actual undertaking itself. Baker was the first, and only, former patent examiner hired by the assignee. Report, page 40. Although there was a general understanding that Baker was precluded from working on some applications, the details of that proscription were not known by other members of the RPR Patent Department. *Id.*, pages 42-45. Savitzky never reviewed Baker's letter from OED defining the scope of his undertaking. *Id.*, pages 21. He did believe in good faith, however, that the practice at RPR regarding Baker did not violate PTO regulations.

Specifically, Savitzky believed that as long as Baker's involvement in an application within the scope of his undertaking was shielded from the PTO, thereby preventing any possibility of an undue influence working to RPR's advantage, he was conducting himself appropriately under, and in compliance with, the rules governing conduct before the PTO. Exh. 17, page 77, line 2 -page 78, line 14. Accordingly, applicants submit that Savitzky did not act with a deliberate intent to deceive the PTO.

Baker provided no confidential information to Golrick, Docherty or Savitzsky during prosecution of the instant application or its parent case. Moreover, applicants received no unfair advantage in the patent examining process. Thus, the fact that Baker may have communicated directly or indirectly to the Calfee attorneys the suggestions of RPR with the respect to certain amendments has no bearing on the merits of the arguments. Accordingly, applicants submit that the conduct of the other

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practitioners does not rise to the level of inequitable conduct. See *Eli Lilly*, 119 F.3d at 1570-71.

II. APPLICANTS PURGE THE EFFECT OF THIS CONDUCT

As explained above, applicants aver that no inequitable conduct was committed. If the conduct disclosed herein were to rise to the level of inequitable conduct, however, the effect of that conduct may be purged. Therefore, in an abundance of caution, applicants hereby submit all relevant information in this paper, as well as the Report and corresponding exhibits, to affect a "cure" or "purge" of any possible inequitable conduct committed by RPR employees in the prosecution of this case.

The controlling precedent on purging inequitable conduct is *Rohm and Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556 (Fed. Cir. 1983). In *Rohm and Haas*, the Federal Circuit set out three requirements that an applicant must satisfy to cure misconduct before the PTO:

The **first** requirement to be met by an applicant, aware of misrepresentation in the prosecution of his application and desiring to overcome it, is that he expressly advise the PTO of its existence stating specifically wherein it resides. The **second** requirement is that, if the misrepresentation is of one or more facts, the PTO be advised what the actual facts are, the applicant making it clear that further examination in light thereof may be required if any PTO action has been based on the misrepresentation. **[Third]**, on the basis of the new and factually accurate record, the applicant must establish patentability of the claimed subject matter.

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Rohm and Haas, 722 F.2d at 1572 (emphasis added). Where an intentional material misrepresentation has been made, a complete cure must be demonstrated by "clear, unequivocal, and convincing evidence." *Id.*

To comply with their duty of candor and fair dealing with the Office, and in accordance with the Federal Circuit's mandate in *Rohm and Haas*, applicants hereby expressly inform the PTO of the following:

1. A former examiner has assisted in prosecuting this application and that assistance may constitute a violation of his § 10.10(b) undertaking. A detailed description of the former examiner's conduct, both in general and specifically as it applies to this application, is described in the attached Report and its supporting exhibits. Also, the facts that are relevant to this application appear in the section entitled "Specific Conduct at Issue in this Application" of this paper.

2. The section entitled "Specific Conduct at Issue in this Application" on pages 4-6 sets forth the actual facts, as developed by an independent investigation performed at the assignee's/licensee's request. This section discloses the most significant instances of the former examiner's involvement with the prosecution of this case. Although no definition of "assisting in any manner" is provided in the regulations, applicants have broadly interpreted it for the purpose of this submission and the Report. Thus, out of caution, all known details of Baker's involvement in the prosecution of this case are presented in the Report and supporting exhibits, particularly Exhibit 14, which are incorporated by reference.

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Applicants are not aware of any PTO actions based on conduct described above. Nonetheless, they request further examination of this application based upon the factually accurate record.

3. Applicants submit that the factually accurate record does not impact on the patentability of the claimed subject matter. The instant facts are unlike a situation where material prior art was deliberately withheld from the PTO—prior art that might render the claims unpatentable. Neither is it like the situation in *Rohm & Haas* where false data is submitted to the PTO with a deliberate intent to deceive.

As discussed above, Baker did not make use of confidential information, he could not have unduly influenced PTO employees because his actions were not known to the Office, and the amendments and arguments submitted to the PTO have already been evaluated on their merits. When viewed in the context of the factually accurate record, the merits of those arguments do not change. If the Office considered them persuasive before, they should still be so. Thus, applicants submit that the disclosed conduct has no effect on the patentability of the claimed invention.

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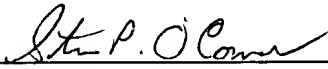
SUMMARY

Applicants believe that this submission satisfies their duties of candor and disclosure to the Office as that duty applies to the conduct described above. They respectfully request further examination of the application in light of this disclosure.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Steven P. O'Connor
Reg. No. 41,225

Dated: May 10, 2001

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